

In re U.S. Patent Application of Jens PETERSEN
Serial No.: 09/938,669 Filing Date: August 27, 2001
Title: POLYACRYLAMIDE HYDROGEL AS A SOFT TISSUE FILLER
ENDOPROSTHESIS

REMARKS

I. Statement

A personal Examiner interview was held on December 9, 2004. During the interview, currently pending claims 27-42 were discussed in view of U.S. Patent No. 5,658,329 to Purkait ("Purkait").

The Examiner suggested that the invention of the Application as claimed might be read on the soft tissue implant filling material disclosed in Purkait. Therefore, the Examiner suggested amending claim 27 to include distinguishing limitations, such as monomer content or "consisting essentially of" to exclude a silicone shell, or alternatively, rewriting all the claims as method of use claims instead of product claims.

In addition, the previous obviousness-type double patenting rejection was also discussed. The Applicant had filed Terminal Disclaimers to the copending patent applications (U.S. Application Nos. 09/938,667; 09/938,668 and 09/938,670) in the interest of expediting prosecution by taking advantage of the statutory opportunity to remove the rejection. However, since the filing of the Terminal Disclaimers, Applicant decided to amend claims in at least some of the copending applications and will do so shortly. Once such claims are amended, the pending claims in two of the applications, namely U.S. Application Nos. 09/938,667 and 09/938,668, clearly will not render obvious the currently pending claims in the Application.

The Examiner stated that a Petition should be filed to withdraw the Terminal Disclaimers. The Petition should provide the claims as they were and as they will be after amendments and further explain that Application claims are no longer obvious over claims of the copending

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applications and therefore, the Terminal Disclaimers should be withdrawn. Applicant appreciates the Examiner's advice and will file the Petition in due course.

II. Amendments and New Claims

Reconsideration of rejections in this application is respectfully requested. Upon entry of the foregoing amendment, claims 27-47 are pending in the Application. Claims 27-29 and 33 are amended. New claims 43-47 are added.

Applicant respectfully requests entry of the above amendment and submits that the amendment does not introduce new matter. Support for the amendments to the claims and the new claims can be found throughout the specification (considered as a whole) and in the claims as originally filed. In particular, support for the amendment to claim 27 can be found, *inter alia*, in claim 27 as originally filed and in the specification at page 2, lines 22-26. Support for the amendment to claims 28, 29 and 33 can be found, *inter alia*, in the specification at page 2, line 25. Support for added claims 43 and 44 can be found, *inter alia*, in the specification at page 5, lines 15-18. Support for added claims 45-47 can be found, *inter alia*, in the specification of U.S. Provisional Application Serial Number 60/228,081, incorporated by reference in the Application and from which the Application claims priority, at page 4, line 32-page 5, line 2.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Claim Rejections

Claims 27-30 and 33-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Purkait. Independent claim 27, from which all remaining claims depend, has been amended to

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reflect that the prosthetic device of the Application does not include a shell or membrane containing a filling material such as that described in Purkait.

Applicant continues to maintain that the claims, prior to their amendment herein, were not obvious in view of Purkait. Nonetheless, in the interest of expediting prosecution, Applicant amended claim 27 to include a limitation further distinguishing the claimed invention of the Application from the disclosure of Purkait as suggested by the Examiner in the interview. Applicant respectfully submits that the rejections over Purkait should be withdrawn.

Claim Objections

Claims 31-33 are objected to as dependent upon a rejected base claim. In view of the amendment to claim 27 as discussed above, Applicant respectfully submits that this objection is rendered moot.

CONCLUSION

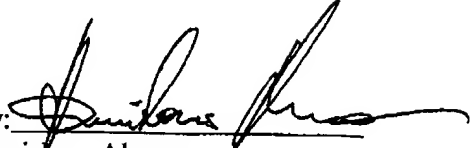
For at least these reasons, Applicant requests that the Application be allowed and passed to issue. In the event any outstanding issues remain, Applicant would appreciate the courtesy of a telephone call to Applicant's undersigned representative to resolve such issues in an expeditious manner.

It is believed that no fees are due. However, if it is determined that fees are required, the Commissioner is authorized to charge such fees to the undersigned's Deposit Account No. 50-0206.

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Respectfully submitted,

Date: December 9, 2004

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